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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/073,931

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Bharat Tarachand Doshi

Doshi 52-2-17-18-1-1

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12/14/2004

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EXAMINER

LESTER, EVELYN A

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/073,931	DOSHI ET AL.	
	Examiner	Art Unit	
	Evelyn A. Lester	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 11 have been amended to include "non-amplified optical signals." There is no original disclosure to provide support for this amendment, therefore these claims and the claims, which depend from them (i.e. claims 2-10 and 12-15), are considered to contain new matter, causing the claims to be properly rejected under 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4-6, 9-11, 14 and 15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fee et al (U.S. patent 5,726,788).

Fee et al disclose the claimed invention of a connection device or router comprising one or more processing units (f1-f7) and an optical switch (308) adapted to connect at least one of the units to one or more optical signals based on a characteristic of each signal.

With respect to claims 4, 5, 9, 11 and 14, please note Figures 3 and 7, and their accompanying text, especially at column 4, line 46 to column 5, line 10, as well as column 5, line 64 to column 6, line 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fee et al (U.S. patent 5,726,788) in view of Wong et al (U.S. patent 6,624,927 B1).

Fee et al disclose the claimed invention as described above, except for explicitly including various specific processing units, such as a Raman pump. However, Fee et al does teach the use of an amplifier and/or pump insertion processing units, as part of necessary signal processing functions. Wong et al teaches that it is well known to utilize

a Raman pump for the purpose of amplifying optical signals in an optical communications network. Therefore, it would have been well known to one of ordinary skill in the art to utilize the well known Raman pump of Wong et al for the purpose of amplifying optical signals and/or pump insertion, thereby providing necessary signal processing functions as taught by Fee et al. Please especially note Fee et al at column 2, line 33 to column 3, line 16; as well as column 4, line 40 to column 5, line 10.

4. Claims 3, 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fee et al (U.S. patent 5,726,788) in view of Sharma et al (6,331,906 B1).

Fee et al disclose the claimed invention as described above, except for explicitly including various specific processing units, such as an optical-electrical-optical regenerator. However, Fee et al does teach the use of a modulation reshaper and the need for regenerating process operation, as part of necessary signal processing functions. Sharma et al teaches that it is well known to utilize an optical-electrical-optical regenerator for the purpose of reshaping optical signals in an optical communications network. Therefore, it would have been well known to one of ordinary skill in the art to utilize the well known optical-electrical-optical regenerator of Sharma et al for the purpose of reshaping optical signals, thereby providing necessary signal processing functions as taught by Fee et al. Please especially note Fee et al at column 2, line 33 to column 3, line 16; as well as column 4, line 40 to column 5, line 10.

Response to Arguments

5. Applicant's arguments filed 6-17-04 have been fully considered but they are not persuasive.

In response to the Applicant's argument that Fee et al does not teach the claimed invention, as amended, is not well received due to the "New Matter" rejection with respect to the amendment to the claims. According to the Applicant's disclosure, it would appear that their invention would work equally well with or without amplified signals, and does not distinguish one way or the other. Therefore, the prior art rejection in light of Fee et al is hereby maintained.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Fee et al does not disavow the use of an optical-to-electrical-to-optical converter. Fee et al do teach that, "[v]arious modules may be plugged into the backplane for performing selective processing of the optical signal without any signal conversion to electrical domain," very much like the Applicant's invention. Therefore, Fee et al teach that various module examples may provide various processing operations, which are clearly taught in column 4, line 46 to column 5, line 10. One of the

processing operations includes "modulation reshaper." Sharma et al teach that an exemplary way to provide modulation reshaping is to use an optical-to-electrical-to-optical converter. Therefore, for the purpose of reshaping the optical signal, it would have been obvious to one of ordinary skill in the art to use the converter of Sharma et al in the invention of Fee et al, because Fee et al allows for various processing operations to be "plugged in to" the optical switch. And Fee et al's invention does not require that any optical signal be converted to an electrical signal before being processed by any module.

In response to applicant's argument that the disclosures of Fee et al and Sharma et al would not be combined because this would appear to render Fee et al's invention inoperable for its intended purpose, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion


6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on M- F, from about 10 am to 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Evelyn A. Lester
Primary Examiner
Art Unit 2873